



Attorney Docket No. A-64411-2 (468267-00067)/RMS/RMK/SPL

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

MEADE, *et al.*

Serial No.: 09/921,645

Filed: August 3, 2001

For: *Metallic Solid Supports Modified
with Nucleic Acids*

Group No. 1637

Examiner: Strzelecka, Teresa, E.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner for Patents, Box 1450 Alexandria, VA 22313-1450 on:

Date:

7/3/03

Signature

Steve Lendaris

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**TERMINAL DISCLAIMER
TO OBVIATE A DOUBLE PATENTING REJECTION**

Mail Stop Fee Amendment
Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, **California Institute of Technology** (hereinafter "Caltech"), represents that it is the assignee of the entire right, title, and interest of:

- (1) the instant application, Serial No. 09/921,645, which is a continuation application of Serial No. 09/639,311, filed 8/15/2000, now U.S. Patent No. 6,291,188, which is a continuation of application Serial No. 08/808,750, filed 2/28/1997, now U.S. Patent No. 6,265,155, which is a continuation-in-part of application Serial No. 08/475,051, filed 6/7/1995, now U.S. Patent No. 5,824,473; and

- (2) U.S. Patent No. 6,291,188, issued 9/18/2001, which is a continuation of
- (3) U.S. Patent No. 6,265,155, issued 7/24/2001.

Written assignment proof for U.S. Patent No. 6,265,155 is recorded in the U.S. Patent and Trademark Office at Reel/Frame 8699/0344. A copy of the assignment is attached to this Terminal Disclaimer.

Caltech hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as shortened by any terminal disclaimer of prior Patent Nos. 6,291,188 and 6,265,155.

Caltech hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patents are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Caltech does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of prior patent Nos. 6,291,188 and 6,265,155, as shortened by any terminal disclaimer, in the event that either of the prior patents later expire for failure to pay a maintenance fee, is held unenforceable, is found

invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee, Caltech.

I, the undersigned, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

Respectfully submitted,
DORSEY & WHITNEY LLP

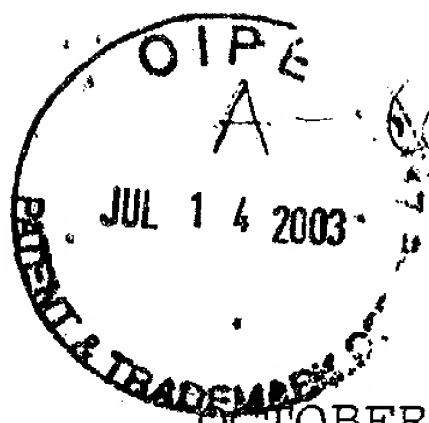
Dated: 7/3/03

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By: 

Renee M. Kossiak, Reg. No 47,717, for
Robin M. Silva, Reg. No. 38,304
Attorney of Record for Assignee

Filed under 37 C.F.R. §1.34(a)



OCTOBER 17, 1997



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NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

RECORDATION DATE: 09/02/1997

REEL/FRAME: 8699/0344
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
MEADE, THOMAS J.

DOC DATE: 07/07/1997

ASSIGNOR:
KAYYEM, JOHN F.

DOC DATE: 07/07/1997

ASSIGNEE:
CALIFORNIA INSTITUTE OF TECHNOLOGY
1200 EAST CALIFORNIA BOULEVARD
PASADENA, CALIFORNIA 91125

SERIAL NUMBER: 08808750
PATENT NUMBER:

FILING DATE: 02/28/1997
ISSUE DATE:

PEARLENE FOSTER, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

09-22-1997



100538351

BT

SEP 02 1997

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

To the Honorable Commissioner of
copy thereof.

rd the attached original documents or

1. Name of conveying party(ies): Thomas J.
Meade and John F. Kayyem

Additional name(s) of conveying
party(ies) attached? ☐ Yes ☒ No

3. Nature of Conveyance:
☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
Execution Date: 7/7/97

2. Name and address of receiving party(ies):
Internal Address: California Institute of
Technology

Street Address: 1200 East California Blvd.

City: Pasadena

State: CA Zip: 91125

Additional name(s) & address(es) attached?
☐ Yes ☒ No

4. Application number(s) or patent number(s):
If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s): 08/808,750
filed 2/28/97

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence
concerning document should be mailed:

Name: Robin M. Silva
Internal Address: FLEHR, HOHBACH, TEST,
ALBRITTON & HERBERT

Street Address: SUITE 3400
FOUR EMBARCADERO CENTER
City: SAN FRANCISCO
State: CA Zip: 94111-4187

6. Total number of applications
and patents involved: 1

7. Total fee (37 CFR 3.41):\$40.00
☒ Enclosed
☐ Authorized to be charged to
deposit account

8. Deposit account number: 06-1300
Please debit any underpayment or credit any
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Our Order No. A-64411/RFT/RMS
(Attach duplicate of this page if paying by deposit
account)

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REED &

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct
and any attached copy is a true copy of the original document.

Robin M. Silva
Reg. No.: 38,304
Name of Person Signing

Robin M. Silva
Signature

August 28, 1997
Date

Total number of pages including cover sheet, attachments and document: [4]

OMB No. 0651-0011 (exp. 4/94)

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Mail documents to be recorded with required cover sheet information to:

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File No. A-64411/RFT/RMS

Rev. 8/93

ASSIGNMENT
(NOT ACCOMPANYING APPLICATION)

WHEREAS, the undersigned,

(1) Thomas J. Meade, (2) Jon F. Kayyem,

(hereinafter termed "Inventors"), residents of

(1) Altadena, (2) Pasadena,

respectively, Counties of

(1) Los Angeles, (2) Los Angeles,

respectively, States of

(1) California, (2) California,

respectively, have invented certain new and useful improvements in

METALLIC SOLID SUPPORTS MODIFIED WITH NUCLEIC ACIDS

and have executed an application for a United States patent disclosing and identifying the invention on the _____ day of _____, 1997; and having Serial No. _____ and filing date of February 28, 1997; and

WHEREAS, California Institute of Technology a corporation of the State of California, having a place of business at 1201 East California Blvd., Pasadena, State of California, (hereinafter termed "Assignee"), is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignee:

1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

3. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.

4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed and delivered this instrument to said Assignee this

(1) 7th day of July, 1997

✓ (2) 7th day of July, 1997

1997 J.F.K

respectively.

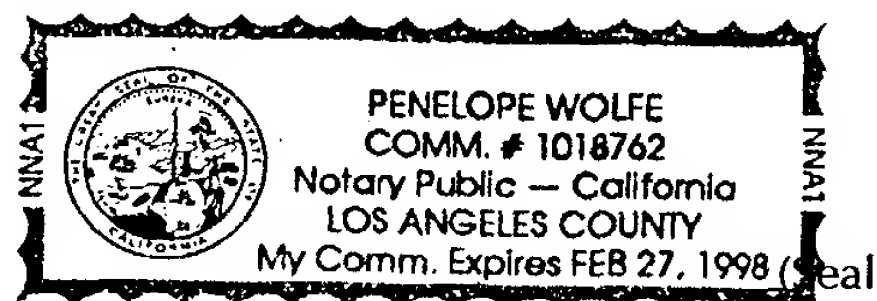
County of Los Angeles
State of California

(1) Thomas J. Meade
Thomas J. Meade
ss.

On this 7th day of July, in the year 1997, before me, Penelope Wolfe, Notary Public of the State of California, personally appeared (1) Thomas J. Meade, personally known to me ~~(or proved to me on the basis of satisfactory evidence)~~ to be the person whose name is subscribed to the within instrument, and acknowledged that he/~~she~~ executed the same in his/~~her~~ authorized capacity~~(ies)~~, and that by his/~~her~~ signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Penelope Wolfe



County of Los Angeles
State of California

(2) Jon F. Kayyem
Jon F. Kayyem
ss.

On this 7th day of July, in the year 1997, before me, Penelope Wolfe, Notary Public of the State of California, personally appeared (2) Jon F. Kayyem, personally known to me ~~(or proved to me on the basis of satisfactory evidence)~~ to be the person whose name is subscribed to the within instrument, and acknowledged that he/~~she~~ executed the same in his/~~her~~ authorized capacity~~(ies)~~, and that by his/~~her~~ signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Penelope Wolfe

